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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/138,464 08/21/98 SHAH

C BAK-073.01

EXAMINER

IM62/0518

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ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/138,464

Applicant(s)

Shah et al

Examiner

D. S. NAKARANI

Group Art Unit

1773



☒ Responsive to communication(s) filed on Aug 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 4-8, 11-14, 16-19, 27, 33-35, 37-39, 43, 44, 52, 55, and 57 is/are pending in the application.

Of the above, claim(s) 1, 4-8, 11-13, 35, 37-39, 43, 44, 52, and 55 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14, 33, and 34 is/are rejected.

☒ Claim(s) 16-19, 27, and 57 is/are objected to.

☒ Claims 1, 4-8, 11-14, 16-19, 27, 33-35, 37-39, 43, 44, 52, 55, and 57 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892 ✓

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 ✓

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 4-8, and 11-13 are, drawn to a coating composition , classified in class 514, subclass 56.
  - II. Claims 14, 16-19, 27, 33, 34 and 57 are, drawn to a medical device, classified in class 604, subclass 265.
2. III. Claims 35, 37-39, 43, 44, 52 and 55 are, drawn to a method of coating, classified in class 427, subclass 2.1.
3. The inventions are distinct, each from the other because:
4. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different products, such as antifouling conduits or pipes.
5. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (composition) as claimed can be used in a materially different process such as molding or casting a thin film.

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6. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as coating a non-medical devices or composition for forming a thin film and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups I or III, restriction for examination purposes as indicated is proper.

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10. During a telephone conversation with Vincent L. Capuano on November 30, 1999 a provisional election was made with traverse to prosecute the invention of II, claims 14, 16-19, 27, 33, 34 and 57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1, 4-8, 11-13, 35, 37-39, 43, 44, 52 and 55 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 14, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsang et. al. (U.S. Patent 5,955,588).

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Tsang et. al. disclose a medical devices such as stunts, catheters, prostheses etc (col. 9, lines 1-7), made of metal such as stainless steel (col. 13, lines 10-12) coated with heparin by reacting with derivative of chloro(chloromethyl)dimethylsilane (col. 9, Example 1).

Therefore given the teaching Tsang et. al. a person of ordinary skill in the art would have found it obvious to react biopolymer with a silane having required functional group to react with biopolymer and other functional group which provides bonding with substrate surface.

15. Claims 16-19, 27, and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Receipt of Information Disclosure Statement filed October 15, 1999 is acknowledged and has been made of record.

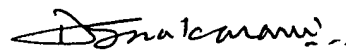
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul J. Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 or 305-3601.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nakarani/mm

May 18, 2000

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**